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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,006	10/17/2003	Russell T. White JR.	END920030046US1	4391
45092 7590 06/17/2010 HOFFMAN WARNICK LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207				
EXAMINER				
LEVINE, ADAM L				
ART UNIT		PAPER NUMBER		
3625				
NOTIFICATION DATE		DELIVERY MODE		
06/17/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

# Office Action Summary

**Application No.**

10/688,006

**Applicant(s)**

WHITE, RUSSELL T.

**Examiner**

ADAM LEVINE

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 15, 2010, has been entered.

Applicant's amendments and remarks filed January 15, 2010, are responsive to the office action mailed November 16, 2009. Independent claims 1, 8, 14, and 19 have been amended and dependent claims 2, 5, 11, and 13 have been amended. Claims 1-2, 5-8, and 10-22 are currently pending and considered in this office action.

### ***Response to Amendment***

#### **Pertaining to rejection under 35 USC 101 in the previous office action**

Claims 8 and 10-12 were rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. The amendments have resolved this issue and this rejection is withdrawn.

***Response to Arguments***

Pertaining to rejection under 35 USC 101 in the previous office action

Applicant's arguments see remarks filed January 15, 2010, have been fully considered and are persuasive. The rejection of claims 14-18 under 35 USC 101 has been withdrawn.

Pertaining to rejection under 35 USC §102(b) in the previous office action

Applicant's arguments filed January 15, 2010, have been fully considered but they are not persuasive. Applicant argues that the references fail to show "storing historical data corresponding to operations performed by each of a plurality of users to locate an item in the hierarchical structure, wherein the operations include each level and corresponding category of the hierarchical structure navigated by the plurality of users," and cite to specification paragraphs 33-34 for support of this feature. This is the same as the previously claimed feature of, *inter alia*, storing operations performed by users. In addition, were it not the same it would be new matter because the support for this feature cited by applicant merely describes the previously claimed feature of storing operations performed by users. "Historical data" is not described, introduced, or even for that matter mentioned whatsoever in the specification. The prior art however does mention "historical data." The reference describes the storage and analysis of "historical data" in great detail as would be clear from even a cursory glance at the abstract, figures, or for that matter almost any randomly chosen page of the disclosure. For example:

"A computer-implemented system and method are provided for identifying popular nodes within a browse tree or other

hierarchical browse structure based on historical actions of online users, and for calling such nodes to the attention of users during navigation of the browse tree. The system and method are particularly useful for assisting users in locating popular products and/or product categories within a catalog of an online merchant, but may be used in connection with browse structures used to locate other types of items. Node popularity levels are determined periodically (e.g., once per day) based on recent user activity data that represents users' affinities for such nodes. Such activity data may include, for example, the number of times each item was purchased, and/or the number of times each category was selected for display, within a selected period of time. Popular nodes are called to the attention of users by automatically "elevating" the nodes for display within the browse tree." (abstract, lines 1-17).

With regard to the role of the administrator introduced only in claim 8, it appears that the administrator is a human being that is given the power to arbitrarily rearrange items as the administrator chooses. This is a problem for many reasons, not least of which is that the option of taking any or no action at all is solely at the whim of the human administrator, and even if the administrator chooses to act, the actions taken are essentially completely arbitrary as far as the method is concerned. There are no clearly defined method steps that are guaranteed to take place. They are all optional at best, and with regard to the determination of "which at least one high frequency item of the identified at least one high frequency item is displayed," it is noted that at least one high frequency item from among at least one high frequency item could mean that there is only one item from which to choose, rendering no determination to be made at all.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 8 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 8 recites the limitation "the group of users" in line 12. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 19-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims reciting a musical composition, literary work, compilation of data, signal, or legal document (e.g., an insurance policy) per se do not appear to be a process, machine, manufacture, or composition of matter. *See, e.g., In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) ("A transitory, propagating signal like Nuijten's is not a process, machine, manufacture, or composition of matter.' ... Thus, such a signal cannot be patentable subject matter.").

The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 USC 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 USC 101*, Aug. 24, 2009; p. 2.

A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 USC 101 by adding the limitation "non-transitory" to the claim. *Cf. Animals -Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 USC 101).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**3. Claims 1-2, 5-8, and 10-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Spiegel (Paper #051102; US Patent No. 6,466,918).**

Spiegel teaches all the limitations of Claims 1-2, 5-8, and 10-22. For example, with regard to method claims 1-13, Spiegel discloses a method executed on at least one computer device of managing items available for electronic purchase, for storing items in a hierarchical structure, allowing users to select items within that structure, identifying frequently purchased items, and elevating them for display on a higher level in the structure than that on which they would normally appear (see at least Abstract, Figs. 1A-4, column 1 lines 5-15). Spiegel further discloses:

- storing items in a hierarchical structure: wherein each of the items is located using a database search query for each level of the hierarchical structure, wherein the query returns a set of records containing the items based on a level of the hierarchical structure selected and queried (see at least Abstract, Figs. 1A-8, column 1 lines 25-59, column 5 line 10-column 6 line 5, column 7 lines 5-25); a page is dynamically generated for a user at a user device based on the result of the query (see at least fig.1A, column 2 lines 25-36, column 5 lines 3-10, column 7 lines 5-24, 59- column 8 line 8);
- storing historical data corresponding to operations performed: by each of a plurality of users to locate an item in the hierarchical structure, wherein the operations include each level and corresponding category of the hierarchical structure navigated by the plurality of users (see at least abstract, figs. 1-4, 5, 7,



9, 11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 6 lines 5-20, column 9 line 64-column 10 line 26);

- identifying by the at least one computer device at least one high frequency item: corresponding to a high level page by analyzing the historical data to identify at least one item that is most frequently located from a high level of the hierarchical structure corresponding to the high level page, item is frequently located from a corresponding level of the hierarchical structure (see at least column 2 lines 36-67, column 6 lines 30-67, column 11 lines 34-67); maintaining a record of the frequency that each of the items has been purchased (see at least Abstract, column 2 lines 12-24, column 3 lines 13-29, column 6 lines 5-20, 30-39. Please note: this element is interpreted as referring to the storage of information regarding the frequency of purchase of each item.); a separate record of the frequency of purchase of each of the items is maintained for each of a plurality of groups of users (see at least column 7 line 59-column 8 line 7, column 9 line 64 – column 10 line 16.);
- receiving a request for a high level page: on the at least one computer device the high level page corresponding to a high level of the hierarchical structure, from a user in the group of users (see at least column 9 line 1—column 10 line 37, column 11 lines 34-50, column 15 line 55 – column 16 line 60);
- automatically generating on the at least one computer device: the high level page using the query for the corresponding high level of the hierarchical structure and the identified (selected) at least one high frequency item to display the at least

one high frequency item on the high level page wherein the high level page is dynamically generated by the at least one computer device in response to receiving the request for the high level page and incorporates the selection of the administrator (see at least Abstract, Figs. 1A,2-4,11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 6 lines 5-20, column 7 lines 5-25);

- presenting the at least one high frequency item to an administrator: for the group of users and receiving a selected at least one high frequency item for display on the high level page for each user in a group of users wherein the administrator determines if the at least one high frequency item is displayed on a high level page and on which high level page the at least one high frequency item is displayed (see at least abstract, figs. 1A, 2-4, 11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 4 line 64-column 5, column 6 lines 5-20, column 7 lines 5-25, column 13 lines 40-50, column 15 lines 10-25); wherein the administrator determines which at least one high frequency item of the identified at least one high frequency item is displayed, if the at least one high frequency item is displayed on a highest level page or the high level page and on which high level page the at least one high frequency item is displayed, and can select an item that is not a high frequency item to be displayed on the highest level page or the high level page (see at least abstract, figs. 1A, 2-4, 11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 4 line 63-column 5 line 67, column 7 lines 5-25, column 13 lines 40-50, column 15 lines 10-25. Please note: The optional claim language regarding what actions may or may not be taken by

the administrator does not result in any further limitation because it merely represents contingencies that are not required. The optional activities of the administrator do not represent clearly defined method steps that definitely take place. In addition, with regard to the determination of "which at least one high frequency item of the identified at least one high frequency item is displayed," it is noted that at least one high frequency item from among at least one high frequency item could mean that there is only one item from which to choose, rendering no determination to be made at all. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.];" and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted."));

- storing the operations performed by a user to select an item in the hierarchical structure: analyzing the stored operations, obtaining the query for each level based on the stored operations (see at least Abstract, Figs. 1-4, 5, 7, 9, 11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 6 lines 5-20, column 9 line 64-column 10 line 26.).

- an identification system for identifying a user: (see at least column 2 line 46 – column 3 line 12, column 6 line 40 – column 7 line 5, column 11 lines 34-50, column 12 line 61 – column 13 line 7).

*Pertaining to system claims 14-18*

Rejection of system claims 14-18 is based on the same rationale as noted above.

*Pertaining to computer program product claims 19-22*

Rejection of computer program product claims 19-22 is based on the same rationale as noted above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam Levine/  
Examiner, Art Unit 3625

Adam Levine  
Patent Examiner  
June 14, 2010